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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/762,963	02/14/2001	Angel Lopez	A20-017	2022

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EXAMINER	
MERTZ, PREMA MARIA	

ART UNIT	PAPER NUMBER
1646	9

DATE MAILED: 08/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/762,963	Applicant(s) LOPEZ ET AL.	
	Examiner Prema M Mertz	Art Unit 1646	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 June 2003* .

2a)☒ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *32-39* is/are pending in the application.

4a) Of the above claim(s) *36-39* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *32-35* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6 .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Claims 1-31 have been canceled previously. Claims 32-39 (Paper No. 5, 2/24/03), are under consideration.

Election/Restriction

1. Applicant's election without traverse of Group I (claims 32-35) in Paper No. 8 (6/12/03) is acknowledged.

Claims 36-39 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

2. Receipt of applicant's arguments and amendments filed in Paper No. 5 (2/24/03) is acknowledged.

3. The following previous rejections and objections are withdrawn in light of applicants amendments filed in Paper No. 5, 2/24/03:

(i) the rejection of claims 1-12, 14-20, 22 and 24-30 under 35 U.S.C. § 112, first paragraph, for scope of enablement;

(ii) the rejection of claim 27 under 35 U.S.C. § 112, first paragraph, for written description;

(iii) the rejection of claims 1-31 under 35 U.S.C. § 112, second paragraph;

(iv) the rejection of claims 1-20, 22, 28-30 under 35 U.S.C. § 102(b) as being anticipated by WO 97/28190; and

(v) the rejection of claims 1-20, 22, 28-30 under 35 U.S.C. § 102(e) as being anticipated by US Patent No. 6,200,567.

4. Applicant's arguments filed in Paper No. 5 (2/24/03), have been fully considered but were persuasive in part. The issues remaining are stated below.

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Specification

6. This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

Claim rejections-35 USC § 112

7. Claims 33-34 are rejected under 35 U.S.C. 112, first paragraph.

This rejection is maintained for reasons of record set forth at pages 2-3 of the previous Office action (Paper No. 3, 8/13/02).

Applicants argue that regarding the deposit of the hybridoma cell line, this is specifically enabled by the deposit, which was made and described in the specification on page 23. However, contrary to Applicants arguments, the rejection of record is being maintained because the hybridoma ATCC HB-12525 recited in claims 33-34 must be obtainable by a repeatable method set forth in the specification or otherwise be readily available to the public. The instant specification does not disclose a repeatable process to obtain the hybridoma, and it is not apparent if the hybridoma is readily available to the public.

If the deposits have been made under the terms of the Budapest Treaty, an affidavit or declaration by applicants or someone associated with the patent owner who is in a position to make such assurances, or a statement by an attorney of record over his or her signature, stating that (1) the hybridomas have been deposited under the Budapest Treaty and that (2) the hybridomas will be **irrevocably and without restriction or condition be released to the public**

upon the issuance of a patent would satisfy the deposit requirement made herein. See 37 CFR 1.808.

Further, the record must be clear that the deposit will be maintained in a public depository for a period of 30 years after the date of deposit or 5 years after the last request for a sample or for the enforceable life of the patent whichever is longer. See 37 CFR 1.806. If the deposit has not been made under the Budapest treaty, then an affidavit or declaration by applicants or someone associated with the patent owner who is in a position to make such assurances, or a statement by an attorney of record over his or her signature must be made, stating that the deposit has been made at an acceptable depository and that the criteria set forth in 37 CFR 1.801-1.809, have been met.

Applicant's attention is directed to *In re Lundak*, 773 F.2d. 1216, 227 USPQ 90 (CAFC 1985), and 37 CFR 1.801-1.809 for further information concerning deposit practice.

Claim rejections-Double Patenting
Non-statutory double patenting rejection (obviousness-type)

8. Claims 32-35 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,200,567.

This rejection is maintained for reasons of record set forth at pages 12-13 of the previous Office action (Paper No. 5, 2/24/03).

Applicants argue that since the claims have been amended significantly from their original scope, the rejection is no longer applicable. However, contrary to Applicants arguments, although the conflicting claims are not identical, they are not patentably distinct from each other.

Claims 1-5 of U.S. Patent No. 6,200, claims an antibody to the common receptor β_c chain. In instant claims, a monoclonal antibody to the common receptor β_c chain is claimed. The

claims in the patent are generic to the claims 1 in the instant application and encompass subject matter to which the instant claims are a species. However, the instant claims are obvious from the patented claims because the instant claims are directed to one specific embodiment encompassed by the patented claims. The instant product is included in the patented product. It would have been obvious to one of ordinary skill in the art at the time the present invention was made, that a monoclonal antibody as claimed, was included in the generic antibody claims of the patent, which encompasses the instant species claims. The patented claims if infringed upon would also result in infringement of the claims of the instant application. Allowance of the pending claim, therefore, would have the effect of extending the enforceable life of the allowed claims beyond the statutory limit.

Conclusion

No claims are allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Advisory Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Prema Mertz whose telephone number is (703) 308-4229. The examiner can normally be reached on Monday-Friday from 7:00AM to 3:30PM (Eastern time).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, can be reached on (703) 308-6564.

Official papers filed by fax should be directed to (703) 305-3014 or (703 308-4242. Faxed draft or informal communications with the examiner should be directed to (703) 746-5300.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [yvonne.eyler@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark Office on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Prema Mertz

Prema Mertz Ph.D.
Primary Examiner
Art Unit 1646
June 23, 2003